

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 2035-38

HIGHFIELD et al

C# M#

Serial No. 09/664,363

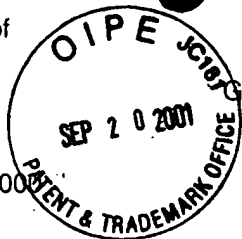
Group Art Unit: 1648

Filed: September 18, 2001

Examiner: Li, B.

Date: September 20, 2001

Title: VIRAL AGENT



#5 16488
 AG
 10-4-01
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 SEP 24 2001

Assistant Commissioner for Patents
 Washington, DC 20231

TECH CENTER 1600/2900

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment 0 minus highest number
 previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number
 previously paid for 3 (at least 3) = 0 x \$ 80.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$270.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$390.00/2 months; \$890.00/3 months) \$ 1390.00

Terminal disclaimer enclosed, add \$ 110.00 \$ 0.00

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$710.00) \$ 0.00

☐ Please enter the previously unentered, filed

☐ Submission attached

Subtotal \$ 1390.00

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 0.00

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: 0.00

TOTAL FEE ENCLOSED \$ 1390.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

1100 North Glebe Road, 8th Floor
 Arlington, Virginia 22201-4714
 Telephone: (703) 816-4000
 Facsimile: (703) 816-4100
 MJW:tat

NIXON & VANDERHYE P.C.
 By Atty: Mary J. Wilson, Reg. No. 32,955

Signature: Mary J. Wilson

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re PATENT APPLICATION OF

HIGHFIELD et al

Serial No.: 09/664,3

Filed: September 18, 2000

For: VIRAL AGENT

Atty. Ref.: 2035-38

Group Art Unit: 1648

Examiner: Li, B.

* * * * *

September 20, 2001

RESPONSE

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

09/21/2001 SZEWDIE1 00000038 09664363

01 FC:118

1390.00 OP

Sir:

In response to the Examiner's requirement for restriction, set forth in the Office Action dated April 20, 2001, Applicants elect the subject matter of Group III (claims 9-13) for prosecution in this application.

In response to the Examiner's requirement for election of a single sequence, Applicants elect the sequence of SEQ ID NO:21, with traverse. Applicants respectfully submit that this requirement for election of a single sequence is inappropriate as MPEP §2434 states that "Under [the policy put forth by the Commissioner's notice in 1192 O.G. 68 (November 19, 1996)], in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction." (Emphasis added.) The requirement here clearly places a monumental burden on Applicants in terms of potential

filing and prosecution costs associated with divisional applications.

Paramount to the considerations of the above policy is the balance which the Commissioner attempted to establish between aiding the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office. The Commissioner determined that the most appropriate way to strike this balance was to "permit a reasonable number of ... nucleotide sequences to be claimed in a single application." See, Notice. The Commissioner set this reasonable number at ten sequences. The Examiner in the present case is requested to at least allow examination of sequences (a)-(h) within each of the relevant Groups, including elected Group III. Restatement of the Restriction Requirement in a further new Office Action, consistent with the Notice of the November 19, 1996, is requested.

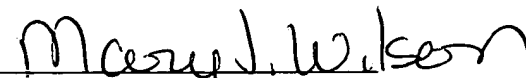
In view of the above, it is requested that the requirement for election of a sequence be restated and issued in a new Office Action requiring election, which comports with the Notice of November 19, 1996, and the requirements of MPEP (specifically, MPEP §808.02). In the event the Examiner refuses to reconsider and restate the requirement for election of a sequence, consideration of the attached Alternate Petition Under Rule 181 is requested.

An early and favorable Action on the merits is awaited.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By



Mary J. Wilson

Reg. No. 32,955

MJW:tat

1100 North Glebe Road

8th Floor

Arlington, Virginia 22201-4714

Telephone: (703) 816-4000

Facsimile: (703) 816-4100